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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,475	09/28/2001	Takuya Okamoto	ASA-724-02	3236
24956	7590	10/19/2006		EXAMINER
				COLBERT, ELLA
			ART UNIT	PAPER NUMBER
				3694

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/964,475	OKAMOTO ET AL.	
Examiner	Art Unit		
Ella Colbert	3694		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 July 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 34-49 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 34-49 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_ .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_\_ .

## **DETAILED ACTION**

1. Claims 34-49 are pending in this communication filed 07/27/06 entered as Response After Non-Final Action (Miscellaneous Communication To Applicant). Applicants' are respectfully requested to submit the following documents on page 2, lines 7-11; page 3, lines 24-26; and page 4, lines 18-22, and page 5, lines 12-16. If they are in Japanese they need to be translated into English and submitted in English.

### ***Title Objection***

2. The Title of the invention is objected to for the following:

The Title recites "METHOD AND APPARATUS FOR SEARCHING AND DISPLAYING STRUCTURED DOCUMENT". The Title would be better recited as "METHOD AND APPARTUS FOR SEARCHING AND DISPLAYING A STRUCTURED DOCUMENT".

### ***Abstract Objection***

3. The abstract is objected to because the abstract contains over 150 words.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

### ***Claim Objections***

4. Claims 34, 42-45, and 49 are objected to because of the following informalities:

Claim 34 in the preamble recites "A structured document searching and displaying of method performing a full-text search on elements designated to a structured document and highlight-displaying information on a position of the document meeting a search result, in an information processing system including a processor, a memory unit, a file unit and an input/output unit, said method comprising steps executed by the processor, said steps comprising:" The preamble would be better recited as "A computer-implemented method for searching and displaying a structured document including performing a full-text search on elements designated to the structured document and highlighted displayed information on a position of the document meeting a search result,

the method comprising the steps of". Claims 34, 42-45, and 49 have a similar problem. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 34, 42 –47, and 49 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claims 34, 42-47 and 49 have steps missing from the claims that are considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 34 in the body of the claim first recites "generating an analyzed result of a structured document to be searched" then begins the next limitation with removing a pre-designated element from the analyzed result of structured document, and concatenating a content character string of a higher-rank element than the removed element with a content character string having the removed element to thereby generate a structured document for full-text search, and further generating information for restoring the removed element; acquiring information on a position meeting a query to the structured document for full-text search; converting the information on the position meeting query to the structured document for the full-document search, into information on a position of the document meeting a query in the original analyzed structured document; additionally adding element information for highlight-displaying the information on the position meeting the

query, to the original analyzed structured document; and generating a text string of the structured document for displaying, from the analyzed structured document with the element information additionally added thereto for highlight-displaying the information on the position meeting the query.” This claim limitation, for example, would be better recited as something similar to the following: “generating an analyzed result of a structured document to be searched; removing a pre-designated element from the analyzed result of the searched structured document, and concatenating a content character string of a higher-rank element than the removed pre-designated element with a content character string; removing the pre-designated element and generating a structured document for a full-text search, and further generating information for restoring the removed pre-designated element; acquiring information on a position meeting a query to the structured document for the full-text search; (**a step is missing here, nothing is being done with the concatenating a content character string of a higher-rank element**); converting the information on the position meeting the query into the structured document for the full-text search of the structured document and into information on a position of the document meeting the query in the original analyzed structured document; adding additional element information for the highlighted displaying of the information on the position meeting the query, to the original analyzed structured document; and generating a text string of the structured document for displaying, from the analyzed structured document with the element information additionally added for highlighted displaying of the information on the position meeting the query.” Claims 42 –47, and 49 have a similar problem.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Correction is required.

Claims 35-41 and 48 are also rejected for their dependency on a rejected base claim.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 34-49 are rejected under 35 USC 112 second paragraph because:

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Correction is required.

It is unclear whether applicants' mean "highlighted displaying" or "highlighted display". Claim 41 is in improper format for a method claim. The claim limitation begins with "in said step of generating a text string of structured document for displaying ... to which the structure information for highlight-displaying the information on the position of the document meeting the query is additionally added,

producing a text string of a structured document for display of sub-elements to be displayed, from sub-elements ...". This claim would be better recited as "generating in said step, a text string of a structured document for displaying from the analyzed structured document to which the structured information for the highlighted display of the information on the position of the document meeting the query is additionally added; and ...." The recitation "producing a text string of a structured document for display of

sub-elements to be displayed, from sub-elements ..." reads very redundant and it cannot be understood what Applicants' are try to claim in the portion of the claim limitation.

Claim 42 is also in improper format for a method claim. The body of the claim in the second claim limitation should begin with "scanning said text ...".

Claims 43-45 have a similar problem with method claim format.

Claims 34, 41-47, and 49 are rejected under 35 USC 112 second paragraph because: Claim 34 recites the limitation "a structured document" in lines 1, 7 and 11 and the limitation "a query" in lines 13 and 17. Claims 41-47 and 49 have a similar problem with antecedent basis. There is insufficient antecedent basis for the limitations in the claims.

### **Claim Rejections - 35 USC § 112**

9. The following is a quotation of the second paragraph of 35 U.S.C. § 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 34 and 48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

A. Claim 48 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the independent claim 34 refers to a method and the dependent claim 48 refers to a system (i.e., computer).

Also, claim 48 recites "A computer-readable medium for storing a program, executable by a computer, for implementing a method according to claim 34." This

claim overlaps two statutory classes of claims. First the preamble of the independent claim recites a method of performing a full-text search ..." and now the dependent claim 48 recites "A computer-readable medium for storing a program, executable by a computer, ..." which is part of a systems claim.

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

12. Claims 34 and 48 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claim 34), the dependent claim 48 discusses the specifics of the system (i.e., computer system)(see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

**Conclusion:** A prior art rejection is not being given at the present time because there are numerous issues to be resolved with the claims.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Saito (US 5,649,218) disclosed a document structure, storing, searching, and retrieving.

Nakatsuyama et al (US 5,802,529) disclosed document structures, document generation, storage and retrieval.

**Inquiries**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 14, 2006



ELLA COLBERT  
PRIMARY EXAMINER